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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Richard W. Berenson

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7590

11/15/2006

WOLF GREENFIELD & SACKS, PC  
FEDERAL RESERVE PLAZA  
600 ATLANTIC AVENUE  
BOSTON, MA 02210-2206

EXAMINER

SHEPARD, JUSTIN E

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 11/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/056,672	<b>Applicant(s)</b> BERENSON ET AL.	
	<b>Examiner</b> Justin E. Shepard	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 14, 16, 18 and 23-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 14, 16, 18 and 23-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8, 9, 10, 14, 16, 23-25, 27-33, 35, 36, and 38-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Imanaka.

Referring to claim 1, Kahn discloses a system for ensuring the recording of programming (column 3, lines 37-41), the system comprising:

a device by which a user places an order for selected programming (column 7, lines 58-62); and a recording device controller connected through at least one communication medium to a recording device (figure 5A, part 528; figure 5B, part 406), the recording device controller whether the recording device is programmed to view the selected programming and canceling the order if the recording device does not verify that the recording device is programmed to view the programming (column 7, lines 62-67; column 4, lines 1-2).

Kahn does not disclose a system wherein the verification determines whether the recording device is programmed to record the programming.

Imanaka discloses a system wherein the verification determines whether the recording device is programmed to record the programming (column 7, lines 61-67).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording canceling taught by Imanaka to the system disclosed by Kahn. The motivation would have been to stop content that was recorded, but the user was not verified to watch, from being unencrypted by illegal means.

Referring to claim 2, Kahn discloses a system of claim 1, wherein the recording device is a digital video recorder (column 3, lines 37-41).

Referring to claim 3, Kahn discloses a system of claim 1, wherein the at least one communication medium is a different medium than a transmit medium used to deliver the selected programming (figure 1).

Referring to claim 4, Kahn discloses a system of claim 1, further comprising a device, which sends the order to a distributor of the selected programming (column 7, lines 58-62).

Referring to claim 5, Kahn discloses a system of claim 1, wherein the recording device controller sends the order to a distributor of selected programming (figure 5B, part 540).

Referring to claim 6, Kahn discloses a system of claim 1, wherein the recording device controller instructs the recording device to record the selected programming (column 10, lines 27-30).

Referring to claim 8, Kahn discloses a system of claim 1, wherein the recording device cannot transfer the selected programming to any other device (column 11, lines 60-61).

Referring to claim 9, Kahn discloses a system for the delivery of programming, the system comprising: an order processor; a program source device

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(figure 1; column 4, lines 51-55); and a user recording device (figure 5A, part 528); the order processor executing instructions to: receive and process an order for a program (column 7, lines 58-62), communicate with the user recording device, communicate with the program server (column 7, lines 62-67), and store user data (column 12, lines 12-16); the program source device executing instructions to: communicate with the order processor (column 7, lines 58-62), send a program to the user recording device, and authorize the receiving of the program by the user recording device (column 7, lines 62-67); and the user recording device executing instructions to: communicate with the order processor (column 7, lines 58-62), receive the program from the program service device, and record the program (column 10, lines 48-51); wherein if the user device is unable to view the program, the order processor cancels the order (column 7, lines 62-67; column 4, lines 1-2).

Kahn does not disclose a system wherein the verification determines whether the recording device is programmed to record the programming.

Imanaka discloses a system wherein the verification determines whether the recording device is programmed to record the programming (column 7, lines 61-67).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording canceling taught by Imanaka to the system disclosed by Kahn. The motivation would have been to stop content that was recorded, but the user was not verified to watch, from being unencrypted by illegal means.

Referring to claim 10, Kahn discloses a system of claim 9, the user recording device further executing instructions to confirm its ability to receive and/or record the program (column 7, lines 62-67).

Referring to claim 14, Kahn discloses instructing the user recording device to record the program (column 10, lines 27-30 and 48-51). The remaining limitations have been addressed in the rejection of claim 9.

Referring to claim 16, Kahn discloses a system for the delivery of programming, the system comprising: a user recording device executing instructions to: communicate commands a program controller (column 7, lines 58-62), receive a program from a program service device (column 10, lines 48-51), and record the program pursuant to a command from the program controller (column 10, lines 27-30).

Kahn does not disclose a system wherein the verification determines whether the recording device is programmed to record the programming.

Imanaka discloses a system wherein the verification determines whether the recording device is programmed to record the programming (column 7, lines 61-67).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording canceling taught by Imanaka to the system disclosed by Kahn. The motivation would have been to stop content that was recorded, but the user was not verified to watch, from being unencrypted by illegal means.

Referring to claim 23, Kahn discloses a system for the delivery of programming, the system comprising: a recording device that performs actions comprising: receiving selected programming (column 10, lines 48-51), recording selected programming (column 10, lines 48-51), and communicating instructions with a programming delivery mechanism (column 7, lines 58-62); and the programming delivery mechanism that performs actions comprising: receiving at least one order for selected programming, (column 7, lines 58-62), and instructing the recording device to record the selected programming (column 10, lines 48-51).

Kahn does not disclose a system wherein the verification determines whether the recording device is programmed to record the programming.

Imanaka discloses a system wherein the verification determines whether the recording device is programmed to record the programming (column 7, lines 61-67).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording canceling taught by Imanaka to the system disclosed by Kahn. The motivation would have been to stop content that was recorded, but the user was not verified to watch, from being unencrypted by illegal means.

Referring to claim 24, Kahn discloses a system of claim 23, wherein the actions performed by the programming delivery mechanism further comprise encoding the selected programming (figure 2, part 202A).



Referring to claim 25, Kahn discloses a system of claim 23 or 24, wherein the actions performed by the recording device further comprise decoding the selected programming (figure 4, part 416).

Referring to claim 27, Kahn discloses a system for ensuring the recording of programming, the system comprising: a programming delivery mechanism that performs actions comprising: receiving an order to purchase selected programming (column 7, lines 58-62); communicating instructions with a recording device (column 10, lines 27-30); instructing the recording device to record the selected programming (column 10, lines 48-51); if the device is not programmed to view the selected programming, canceling the order (column 7, lines 62-67; column 4, lines 1-2).

Kahn does not disclose a system wherein the verification determines whether the recording device is programmed to record the programming.

Imanaka discloses a system wherein the verification determines whether the recording device is programmed to record the programming (column 7, lines 61-67).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording canceling taught by Imanaka to the system disclosed by Kahn. The motivation would have been to stop content that was recorded, but the user was not verified to watch, from being unencrypted by illegal means.

Referring to claim 28, Kahn does not disclose a system of claim 27, wherein the actions performed by the programming delivery mechanism further comprise: if the

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recording device is not programmed to record the selected programming perform one or more of the following actions: send a notification that the order was cancelled; reschedule the order; and instruct the recording device to record the selected programming according to the rescheduled order.

Imanaka discloses a system of claim 27, wherein the actions performed by the programming delivery mechanism further comprise: if the recording device is not programmed to record the selected programming perform one or more of the following actions: send a notification that the order was cancelled (column 7, lines 61-67 and 35-41); reschedule the order; and instruct the recording device to record the selected programming according to the rescheduled order.

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording canceling taught by Imanaka to the system disclosed by Kahn. The motivation would have been to stop content that was recorded, but the user was not verified to watch, from being unencrypted by illegal means.

Claim 35 is rejected on the same grounds as claim 28.

Referring to claim 29, Kahn discloses a system of claim 27 or 28, wherein the actions performed by the programming delivery mechanism further comprise sending the selected programming to the recording device (figure 5A parts 512, 514, and 528).

Referring to claim 30, Kahn discloses a system of claim 29, wherein the actions performed by the programming delivery mechanism further comprise encoding the selected programming (figure 2, part 202A).

Referring to claim 31, Kahn discloses a system for ensuring the recording of programming, the system comprising: a recording device that performs actions comprising: receiving purchased programming (column 10, lines 48-51); recording the purchased programming (column 10, lines 48-51); communicating instructions with a programming delivery mechanism (column 7, lines 58-62); and verifying to the programming delivery mechanism that the device is programmed to view a particular purchased program (column 7, lines 62-67).

Kahn does not disclose a system wherein the verification determines whether the recording device is programmed to record the programming.

Imanaka discloses a system wherein the verification determines whether the recording device is programmed to record the programming (column 7, lines 61-67).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the recording canceling taught by Imanaka to the system disclosed by Kahn. The motivation would have been to stop content that was recorded, but the user was not verified to watch, from being unencrypted by illegal means.

Referring to claim 32, Kahn discloses a system of claim 31, wherein the actions performed by the recording device further comprise displaying the particular purchased program (figure 5A, part 530).

Referring to claim 33, Kahn discloses a system of claim 31, wherein the actions performed by the recording device further comprise decoding the purchased programming (figure 4, part 416).

Referring to claim 36, Kahn discloses a method of claim 35, wherein the recording device is a digital video recorder (column 3, lines 37-41).

Referring to claim 38, Kahn discloses a method of claim 35, further comprising sending the order to a distributor of the selected programming (column 7, lines 58-62).

Referring to claim 39, Kahn discloses a method of claim 35, further comprising instructing the recording device to record the selected programming (column 10, lines 27-30).

Referring to claim 40, Kahn discloses a method of claim 35, wherein the verifying includes determining that the recording device cannot transfer the selected program to any other device (column 11, lines 60-61).

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Imanaka as applied to claim 1 above, and further in view of Towell.

Referring to claim 7, Kahn and Imanaka do not disclose a system of claim 1, wherein the recording device controller notifies the user of a status of the order.

Towell discloses a system of claim 1, wherein the recording device controller notifies the user of a status of the order (column 4, lines 29-30).

At the time of the invention it would have been obvious for one of ordinary skill in the art to add the notification taught by Towell to the system disclosed by Kahn and Imanaka. The motivation would have been indicate to the user a problem has occurred so that they would be able to fix what is causing the issue.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Imanaka as applied to claim 16 above, and further in view of Novak.

Referring to claim 18, Kahn and Imanaka do not disclose a system of claim 16, wherein the program is received from the program service device along the same medium as the commands are communicated with the program controller.

Novak discloses a system of claim 16, wherein the program is received from the program service device along the same medium as the commands are communicated with the program controller (page 3, column 1, lines 2-5).

At the time of the invention it would have been obvious for one of ordinary skill in the art to transmit the upstream and downstream data over the same medium as taught by Novak in the system disclosed by Kahn and Imanaka. The motivation would have

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been to enable higher speed transfers in the upstream communication by transmitting the commands by satellite.

Claims 26 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Imanaka as applied to the claims above, and further in view of Rosengren.

Referring to claim 26, Kahn and Imanaka do not disclose a system of claim 23 or 24, further comprising: a decoding device that performs actions comprising: decoding the selected programming; and sending the decoded selected programming to the recording device.

Rosengren discloses a system of claim 23 or 24, further comprising: a decoding device that performs actions comprising: decoding the selected programming; and sending the decoded selected programming to the recording device (figure 8A, part 82; column 2, lines 53-54).

At the time of the invention it would have been obvious to one of ordinary skill in the art to add the transcoder (combination decoder/encoder) taught by Rosengren to the system disclosed by Kahn and Imanaka. The motivation would have been to enable the system to record the feed at a lower quality to save space on the recording device (Rosengren: column 2, lines 7-9)

Referring to claim 34, Kahn and Imanaka do not disclose a system of claims 31, 32 or 33, wherein the actions performed by the recording device further comprise encoding the particular purchased program.

Rosengren discloses a system of claims 31, 32 or 33, wherein the actions performed by the recording device further comprise encoding the particular purchased program (figure 8A, part 82; column 2, lines 53-54).

At the time of the invention it would have been obvious to one of ordinary skill in the art to add the transcoder (combination decoder/encoder) taught by Rosengren to the system disclosed by Kahn and Imanaka. The motivation would have been to enable the system to record the feed at a lower quality to save space on the recording device (Rosengren: column 2, lines 7-9).

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kahn in view of Imanaka as applied to claim 35 above, and further in view of Nations.

Referring to claim 37, Kahn and Imanaka do not disclose a method of claim 35, wherein the order is placed over the Internet.

Nations discloses a method of claim 35, wherein the order is placed over the Internet (column 7, lines 9-13).

At the time of the invention it would have been obvious for one of ordinary skill in the art to use the internet application to order movies, as taught by Nations, in the system disclosed by Kahn and Imanaka. The motivation would have been to use an

existing protocol such, as an Internet protocol, to transmit the requests to enable the set top box to use off the shelf components.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin E. Shepard whose telephone number is (571) 272-5967. The examiner can normally be reached on 7:30-5 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JS



CHRISTOPHER GRANT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600